

PATENT APPLICATION *16w*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shiv Kumar AGARWAL et al.

Attn: **Mail Stop Missing Parts**

Application No.: 10/827,368

Filed: April 20, 2004

Docket No.: 115683.01

For: NOVEL PYRIMIDON DERIVATIVES

RENEWED PETITION UNDER 37 C.F.R. 1.55 (c)

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision Dismissing Petition Under 37 C.F.R. 1.55 (c) mailed January 27, 2005 (copy attached), applicants submit the following information.

In an original Petition for Acceptance of Unintentionally Delayed Claim for Priority (copy attached) filed on August 30, 2004, applicants requested acceptance of an unintentionally delayed claim for foreign priority in the above-identified patent application. Along with that Petition applicants submitted the required Claim for Priority, the Petition fee under 37 C.F.R. 1.17(t), and the required statement that the entire delay in filing the Claim for Priority was unintentional. See Petition (copy attached).

In the Decision mailed September 22, 2004, it was indicated that the Petition was dismissed because it failed to include the Decision also indicated that the priority information was not included in either the oath or Declaration or in the Application Data Sheet in accordance with 37 C.F.R. 1.76(b)(6).

In response to the indication in the Decision that the priority information was not included in either the Oath or Declaration or an Application Date Sheet, submitted herewith is a substituted Application Data Sheet properly including the priority information. Applicant respectfully request entry of the substitute Application Data Sheet and the priority information contained therein.

For all the above reasons, the applicants respectfully submit that the Petition filed on August 30, 2004, and the instant Renewed Petition included all of the necessary information and documentation required for grantable petition under 37 C.F.R. 1.55 (c). Accordingly applicants respectfully request that the Petition be granted.

The petition fee under C.F.R. 1.17(t) was timely paid with Petition filed on August 30, 2004. However, please credit or debit deposit account number 15-0461 as needed to insure consideration of this Petition. Two duplicate copies of this paper are attached.

Should there be any question regarding this matter, the examiner is invited to contact the undersigned representative at the telephone number listed below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Eric D. Morehouse
Registration No. 38,565

JAO:EDM/bmf

Attachments:

Decision dated January 27, 2005
Renewed Petition dated November 5, 2004
Decision dated September 22, 2004
Petition dated August 30, 2004
August 30, 2004 date-stamped postcard receipt
Claim for Priority
Substitute Application Data Sheet

Date: February 2, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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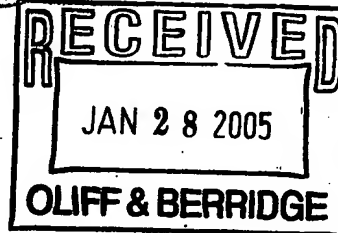
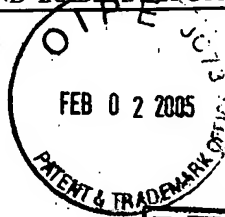


UNITED STATES PATENT AND TRADEMARK OFFICE

MLO

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United States Patent and Trademark Office
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P.O. BOX 19928
ALEXANDRIA, VA 22320



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JAN 27 2005

OFFICE OF PETITIONS

In re Application of
Shiv Kumar Agarwal et.al
Application No. 10/827,368
Filed: April 20, 2004
Attorney Docket No. 115683.01

DECISION DISMISSING
PETITION UNDER
37 CFR 1.55(c)

This is a decision on the renewed petition, filed November 5, 2004, under 37 CFR 1.55(c), requesting acceptance of an unintentionally delayed claim under 35 U.S.C. § 119 (a) - (d) for benefit of the filing date of the following foreign application: Indian Application No. 266/MAS/2002, filed October 4, 2002.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge of \$1,330.00, as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

By fax: (703) 872-9306
ATTN: Office of Petitions

Any inquiries pertaining to this matter may be directed to Wan Laymon at (571) 272-3220.


Frances Hicks

Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shiv Kumar AGARWAL et al.

Attn: **Mail Stop Missing Parts**

Application No.: 10/827,368

Filed: April 20, 2004

Docket No.: 115683.01

For: NOVEL PYRIMIDON DERIVATIVES

RENEWED PETITION UNDER 37 C.F.R. 1.55 (c)

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision Dismissing Petition Under 37 C.F.R. 1.55 (c) mailed September 22, 2004 (copy attached), applicants submit the following information.

In an original Petition for Acceptance of Unintentionally Delayed Claim for Priority (copy attached) filed on August 30, 2004, applicants requested acceptance of an unintentionally delayed claim for foreign priority in the above-identified patent application. Along with that Petition applicants submitted the required Claim for Priority, the Petition fee under 37 C.F.R. 1.17(t), and the required statement that the entire delay in filing the Claim for Priority was unintentional. See Petition (copy attached).

In the Decision mailed September 22, 2004, it was indicated that the Petition was dismissed because it failed to include the proper Claim for Priority, identifying the prior foreign application by the application number, country and filing date. The Decision also indicated that the priority information was not included in either the oath or Declaration or in the Application Data Sheet in accordance with 37 C.F.R. 1.76(b)(6).

In response to the statement in the Decision that the original Petition did not include the proper Claim for Priority, applicants respectfully submit that the Claim for Priority and a certified copy of the priority document was filed together with the Petition. Attached hereto is a copy of the date-stamped postcard receipt, indicating that the August 30, 2004, filing included the Petition for Acceptance of Unintentionally Delayed Claim for Priority, the Claim for Priority and the Indian priority document, i.e., certified copy of the priority application. A copy of the Claim for Priority, requesting priority benefit to Indian Patent Application No. 266/MAS/2002 filed on October 4, 2004 is also attached hereto. Applicants believe that the Claim for Priority and the certified copy of the priority document may have been entered in the patent application file rather than being attached to the Petition when the Petition was forwarded to the Office of Petitions. However the attached documents demonstrate that the Petition was filed together with the Claim for Priority, identifying the priority application by application number, country and filing date, as required by 37 C.F.R. 1.55 (c).

In response to the indication in the Decision that the priority information was not included in either the Oath or Declaration or an Application Date Sheet, submitted herewith is a substituted Application Data Sheet properly including the priority information. Applicant respectfully request entry of the substitute Application Data Sheet and the priority information contained therein.

For all the above reasons, the applicants respectfully submit that the Petition filed on August 30, 2004, and the instant Renewed Petition included all of the necessary information and documentation required for grantable petition under 37 C.F.R. 1.55 (c). Accordingly applicants respectfully request that the Petition be granted.

The petition fee under C.F.R. 1.17(t) was timely paid with Petition filed on August 30, 2004. However, please credit or debit deposit account number 15-0461 as needed to insure consideration of this Petition. Two duplicate copies of this paper are attached.

Should there be any question regarding this matter, the examiner is invited to contact the undersigned representative at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA/mla

Attachments:

Decision dated September 22, 2004
Petition dated August 30, 2004
August 30, 2004 date-stamped postcard receipt
Claim for Priority

Date: November 5, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shiv Kumar AGARWAL et al.

Application No.: 10/827,368

Filed: April 20, 2004

Docket No.: 115683.01

For: NOVEL PYRIMIDON DERIVATIVES

**PETITION FOR ACCEPTANCE OF
UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for acceptance of an unintentionally delayed claim for foreign priority in the above-identified application.

The above-referenced application was filed on April 20, 2004, as a Continuation-in-Part (CIP) of parent U.S. Patent Application No. 10/409,045, filed April 9, 2003. In the parent application, a claim for foreign priority was timely made under 37 C.F.R. §1.55(a). However, in filing the CIP application, Applicants' attorney unintentionally omitted the claim for foreign priority. Promptly upon noting this error, Applicants are now filing this Petition and a Claim for Priority.

Applicants hereby provide the following required items for a grantable petition:

- (1) Claim for Priority.

(2) Petition Fee under 37 C.F.R. §1.17(t) in the amount of \$1,300. Please credit or debit deposit account number 15-0461 as needed to ensure consideration of this petition. Two duplicate copies of this paper are attached.

(3) The instant statement that the entire delay in filing the Claim for Priority between the date the claim for priority was due under 37 C.F.R. §1.55(a)(1) (i.e., August 20, 2004) and its filing was unintentional.

Applicants submit that the requirements for a grantable Petition have been met. Accordingly, applicants respectfully request that this Petition be granted, and that the attached Claim for Priority be accepted.

Should there be any questions regarding this matter, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA/bmf
August 30, 2004

Attachment:
Claim for Priority

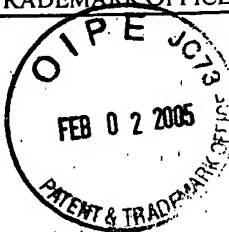
OLIFF & BERRIDGE, PLC
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Telephone: (703) 836-6400



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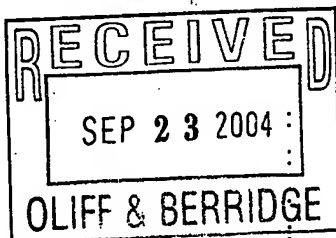


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SEP 22 2004

OFFICE OF PETITIONS

In re Application of
Shiv Kumar Agarwal et al
Application No. 10/827,368
Filed: April 20, 2004
Attorney Docket No. 115683.01



DECISION DISMISSING
PETITION UNDER
37 CFR 1.55(c)

This is a decision on the petition, filed August 30, 2004, under 37 CFR 1.55(c), requesting acceptance of an unintentionally delayed claim under 35 U.S.C. § 119 (a) - (d) for benefit of the filing date of the following foreign application: Indian Application No. 266/MAS/2002, filed October 4, 2002.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date;
- (3) the surcharge of \$1,330.00, as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The above-identified pending nonprovisional application was filed on April 20, 2004, which is after November 29, 2000, and did not include a reference to the foreign applications, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign applications. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is

an appropriate petition under the provisions of 37 CFR 1.55(c).

The petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 119(a) - (d) is **dismissed**. The petition lacks item (2).

A review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet in accordance with 37 CFR 1.76(b)(6). Unless provided in an application data sheet, 37 CFR 1.63 requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP 201.14, page 200-87 (Rev. 1, Feb. 2003), last paragraph, second column.

In view of the above, compliance with 37 CFR 1.63 must be satisfied if applicant desires to claim priority to the foreign applications noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)" and should be submitted within two months from the mail date of this decision. *Note* 37 CFR 1.181(f).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Window located at:
 U.S. Patent and Trademark Office
 220 20th Street S
 Customer Window, Mail Stop Petitions
 Crystal Plaza Two Lobby, Room 1B03
 Arlington, VA 22202

By fax: (703) 872-9306
 ATTN: Office of Petitions

Any inquiries pertaining to this matter may be directed to Wan Laymon at (703) 306-5685.¹


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ Effective September 27, 2004, the phone number will be 571-272-3220.

PTO RECEIPT FOR FILING OF PAPERS

► Mail Room (Regular Delivery)

The following papers have been filed:

Res.NTFMPs; CH#157787 (\$130); Dec; Des. of 10 Attys; CopyNTFMPs; Req.Corr.PALM;
Mark-up OFR; Supp.App.Data.; Pet. for Acceptance of Unintentionally Delayed Claim for
Priority; Clm.Priority.; Indian Priority Doc.

Name of Applicant: Shiv Kumar AGARWAL et al.

Serial No.: 10/827,368

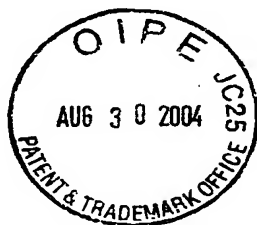
Atty. File No.: 115683.01

Title (New Cases):

Sender's Initials: JAO/bmf

23/30

PATENT OFFICE DATE STAMP



**COPY TO BE STAMPED BY PATENT OFFICE
AND RETURNED BY MESSENGER**

Oliff & Berridge, PLC

277 S. Washington Street, Suite 500, Alexandria, Virginia 22314

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

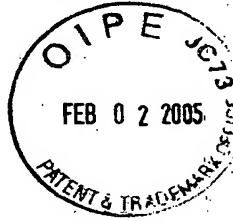
Shiv Kumar AGARWAL et al.

Application No.: 10/827,368

Filed: April 20, 2004

Docket No.: 115683.01

For: NOVEL PYRIMIDON DERIVATIVES



CLAIM FOR PRIORITY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The benefit of the filing date of the following prior foreign application filed in the following foreign country is hereby requested for the above-identified patent application and the priority provided in 35 U.S.C. §119 is hereby claimed:

Indian Patent Application No. 266/MAS/2002 filed on October 4, 2002

In support of this claim, a certified copy of said original foreign application:

☒ is filed herewith.

It is requested that the file of this application be marked to indicate that the requirements of 35 U.S.C. §119 have been fulfilled and that the Patent and Trademark Office kindly acknowledge receipt of this document.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA/mlo

Date: August 30, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**

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necessary for entry;

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